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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/519,278
Filing Date: December 22, 2004
Appellant(s): WONG ET AL.

D. Scott Moore
(Reg. No. 42,011)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/13/2008 appealing from the Office action mailed 11/28/2007.

1. *Real Party in Interest*

A statement identifying by name the real party in interest is contained in the brief.

2. *Related Appeals and Interferences*

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

3. *Status of Claims*

The statement of the status of claims contained in the brief is correct.

4. *Status of Amendments*

The appellant's statement of the status of amendments contained in the brief is correct.

5. *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

6. *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

7. *Claims Appendix*

The copy of the appealed claims contained in Appendix A of the brief is correct.

8. Evidence Relied Upon

6044275	Boltz et al.	03-1998
20030023759	Littleton et al.	11-2000
20010021649	Kinnunen	12-2000
6625460	Patil	12-1999

9. Grounds of Rejection

No new grounds of rejection have been introduced.

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 4-5, 8-9, 11-12, 15-16, 19-20, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boltz et al. (US 6,044,275) in view of Littleton et al. (US 2003/0023759 A1).

Regarding claim 1 Boltz teaches a method for automatically sending electronic messages from a portable communication device to a selected recipient (see col. 3, lines 24-28). Boltz teaches retrieving date information from an electronic date determination unit (see col. 5,

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lines 1-4). Boltz teaches retrieving first recipient related information from a memory, the first recipient related information being date information associated with the recipient (see col. 4, lines 63-67 and col. 5, lines 2-3). Boltz teaches automatically sending a pre-configured electronic message over a network to the recipient based on the date information and the first recipient related information (see col. 4, lines 63-67 and col. 5, lines 1-8). Boltz does not specifically teach an electronic contact register and first recipient related information being personal date information. Littleton teaches retrieving contact information from an electronic contact register (see paragraph [0020]). Littleton teaches contact information from an electronic contact register including personal date information (see paragraph [0021]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include an electronic contact register and first recipient related information being personal date information because it is well known in the art for mobile devices such as the one in Boltz to provide an address book or contact register for storing information and indeed Boltz does disclose that the date information is entered and stored on the mobile station (col. 3, lines 64-67).

Regarding claim 4 Boltz and Littleton teach a device as recited in claim 1 except for retrieving second recipient related information from the electronic contact register; and automatically sending the pre-configured electronic message over the network to the recipient based on the second recipient information. Boltz does teach retrieving recipient related information from a memory (see col. 4, lines 63-67 and col. 5, lines 2-3). Boltz does teach automatically sending a pre-configured electronic message over a network to the recipient based on recipient related information (see col. 4, lines 63-67 and col. 5, lines 1-8). Littleton does

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teach retrieving contact information from an electronic contact register (see paragraph [0020]).

Littleton does teach contact information from an electronic contact register including personal date information (see paragraph [0021]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include retrieving second recipient related information from the electronic contact register; and automatically sending the pre-configured electronic message over the network to the recipient based on the second recipient information because it is well known in the art for mobile devices such as the one in Boltz to provide an address book or contact register for storing information and Boltz does disclose that the date information is entered and stored on the mobile station (col. 3, lines 64-67).

Regarding claim 5 Boltz and Littleton teach a device as recited in claim 4 except for wherein the second recipient related information is a message flag. Boltz does teach recipient related information including a message (see col. 4, lines 63-67 and col. 5, lines 2-3). Littleton does teach a message flag (see paragraph [0029]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include wherein the second recipient related information is a message flag because it would allow for more control over delivery of messages sent from one device to another (see Boltz, col. 3, lines 18-21).

Regarding claim 8 Boltz teaches sending the message directly to a terminal of the recipient (see col. 5, lines 1-8).

Regarding claim 9 Boltz teaches wherein the message is sent to a remote server, which pushes it to a terminal of the recipient (see col. 4, lines 25-32, SMS service center that stores message relates to remote server).

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Regarding claim 11 Littleton teaches wherein the contact register is a register containing previously stored information about contacts and how these can be reached (see paragraph [0022]).

Regarding claim 12 Boltz teaches a method for automatically sending electronic messages from a portable communication device to a selected recipient (see col. 3, lines 24-28). Boltz teaches an electronic date determination unit (see col. 5, lines 1-4). Boltz teaches a message transfer unit (see col. 5, lines 5-8). Boltz teaches a pre-configured message store (see col. 4, lines 64-67). Boltz teaches retrieving date information from the electronic data determination unit (see col. 5, lines 1-4). Boltz teaches first recipient related information being date information associated with the recipient (see col. 4, lines 63-67 and col. 5, lines 2-3). Boltz teaches automatically sending a pre-configured electronic message to the recipient based on the data information and the first recipient related information (see col. 4, lines 63-67 and col. 5, lines 1-8). Boltz does not specifically teach first recipient related information relating to a recipient from an electronic contact register and first recipient related information being personal date information. Littleton teaches first recipient related information relating to a recipient from an electronic contact register (see paragraph [0020]). Littleton teaches contact information from an electronic contact register including personal date information (see paragraph [0021]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include first recipient related information relating to a recipient from an electronic contact register and first recipient related information being personal date information because it is well known in the art for mobile devices such as the one in Boltz to provide an

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address book or contact register for storing information and indeed Boltz does disclose that the date information is entered and stored on the mobile station (col. 3, lines 64-67).

Regarding claim 15 Boltz and Littleton teach a device as recited in claim 4 and is rejected given the same reasoning as above.

Regarding claim 16 Boltz and Littleton teach a device as recited in claim 5 and is rejected given the same reasoning as above.

Regarding claim 19 Boltz and Littleton teach a device as recited in claim 8 and is rejected given the same reasoning as above.

Regarding claim 20 Boltz and Littleton teach a device as recited in claim 9 and is rejected given the same reasoning as above.

Regarding claim 22 Boltz teaches a communication device that is a cellular phone (see paragraph (see col. 5, lines 1-3 and FIG. 3).

Regarding claim 23 Boltz and Littleton teach a device as recited in claim 11 and is rejected given the same reasoning as above.

Regarding claim 24 Boltz teaches a computer program product stored on a computer readable medium (see col. 4, lines 38-41). Boltz teaches retrieving date information from an electronic date determination unit (see col. 5, lines 1-4). Boltz teaches retrieving first recipient related information from a memory, the first recipient related information being date information associated with the recipient (see col. 4, lines 63-67 and col. 5, lines 2-3). Boltz teaches automatically sending a pre-configured electronic message over a network to the recipient based on the date information and the recipient related information (see col. 4, lines 63-67 and col. 5, lines 1-8). Boltz does not specifically teach an electronic contact register and first recipient

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related information being personal date information. Littleton teaches retrieving contact information from an electronic contact register (see paragraph [0020]). Littleton teaches contact information from an electronic contact register including personal date information (see paragraph [0021]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include an electronic contact register and first recipient related information being personal date information because it is well known in the art for mobile devices such as the one in Boltz to provide an address book or contact register for storing information and indeed Boltz does disclose that the date information is entered and stored on the mobile station (col. 3, lines 64-67).

2. Claims 6-7 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boltz et al. (US 6,044,275) in view of Littleton et al. (US 2003/0023759 A1) and Kinnunen et al. (US 2001/0021649 A1).

Regarding claim 6 Boltz and Littleton teach a device as recited in claim 1 except for prompting a user, after retrieving date and recipient related information, about sending the message; and sending the message if the user has accepted sending. Kinnunen teaches prompting a user, after retrieving date and recipient related information, about sending the message; and sending the message if the user has accepted sending (see paragraph [0017] and FIG. 2 & FIG. 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include prompting a user, after retrieving date and recipient related information, about sending the message; and sending the message if the

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user has accepted sending because it would allow for more control over delivery of messages sent from one device to another (see Boltz, col. 3, lines 18-21).

Regarding claim 7 Kinnunen teaches retrieving a name of the recipient from a contact register; and inserting the name into the message prior to sending (see paragraph [0019] and FIG. 2).

Regarding claim 17 Boltz, Littleton, and Kinnunen teach a device as recited in claim 6 and is rejected given the same reasoning as above.

Regarding claim 18 Boltz, Littleton, and Kinnunen teach a device as recited in claim 7 and is rejected given the same reasoning as above.

3. Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boltz et al. (US 6,044,275) in view of Littleton et al. (US 2003/0023759 A1) and Patil (US 6,625,460 B1).

Regarding claim 10 Boltz and Littleton teach a device as recited in claim 1 except for wherein contact information about a recipient is first received from a remote server and then placed in the contact register. Patil teaches wherein contact information about a recipient is first received from a remote server and then placed in the contact register (see col. 5, lines 60-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make device adapt to include wherein contact information about a recipient is first received from a remote server and then placed in the contact register because it would allow for more control over delivery of messages sent from one device to another (see Boltz, col. 3, lines 18-21).

Regarding claim 21 Boltz, Littleton, and Patil teach a device as recited in claim 10 and is rejected given the same reasoning as above.

10. *Response to Arguments*

Claims 1, 12, and 24 are unpatentable under 35 U.S.C. 103(a) as being obvious over Boltz et al. (US 6,044,275) in view of Littleton et al. (US 2003/0023759 A1).

Regarding claims 1, 12, and 24 appellant argues that neither Boltz nor Littleton disclose or suggest, at least, associating personal date information with a recipient and storing the personal date information in a contact register and also sending a pre-configured electronic message to the recipient based on the personal date information and date information retrieved from an electronic date determination unit. The examiner disagrees with this argument because *first*, claims 1, 12, and 24 **do not recite** storing the personal date information nor do they recite sending a pre-configured electronic message to the recipient based on the personal date information and date information; and *secondly*, the argument attacks the references individually, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The combination of Boltz and Littleton does teach a device as claimed. Appellant does not dispute that Boltz teaches a system in which a user, i.e., a message sender, can define a date and time that an electronic message is to be delivered (see Boltz, col. 3, lines 24-28) and that Boltz teaches automatically sending a pre-configured electronic message over a network to the recipient based on the date information and first recipient related information (see Boltz, col. 4,

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lines 63-67 and col. 5, lines 1-8, retrieved system date and time information reads on date information (col. 5, lines 1-4) and user defined date and time that an electronic message is to be delivered to the recipient reads on first recipient related information (see col. 4, lines 63-67)).

However, appellant does dispute *first*, that Boltz discloses associating personal date information with a recipient and storing the personal date information in a contact register; *second*, that Boltz discloses sending the electronic message based on personal date information associated with the recipient; *third*, that Littleton discloses using personal date information as a basis for sending an electronic message; and *forth*, that the birthday information Littleton can be stored in the custom field without destroy the intent, purpose, and function of the telephony system of Littleton.

In response to the *first* argument applicant has improperly argued limitations not recited in the claims and attacked the references individually. Claims 1, 12, and 24 **do not recite** storing the personal date information in a contact register. Claims 1, 12, and 24 **do recite** first recipient related information being personal date information associated with the recipient; and retrieving first recipient related information from an electronic contact register. As explained in the Final Action and the rejection above, claims 1, 12, and 24 are rejected under 35 U.S.C. 103(a) based on the combination of Boltz and Littleton. Boltz teaches sending a pre-configured electronic message to the recipient based on date information and a user defined date and time that is retrieved from a memory (see Boltz, col. 3, lines 24-28 and col. 4, lines 63-67). This user defined date and time retrieved from memory reads on the claimed first recipient related information because the date and time the pre-configured message is to be delivered to the recipient is information that is directly related to the recipient (see Boltz col. 5, lines 29-32).

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Littleton is being combined with Boltz to teach that date and time information related to the recipient in Boltz can be personal date and time information associated with the recipient.

Littleton teaches birthday information (see Littleton, paragraph [0021]). The birthday information in Littleton reads on the claimed personal date information because birthday information obviously relates to the date and time a person was born. Such information can be associated with the recipient in Boltz because the recipient in Boltz is clearly a person. Littleton is also being combined with Boltz to teach that the memory where the user defined date and time information related to the recipient is retrieved in Boltz can be an electronic contact register.

Littleton teaches an address book database containing birthday information (see paragraph [0021]). The address book database in Littleton reads on the claimed electronic register because it is where contacts are registered (see Littleton, paragraph [0020]). The user defined date and time information related to the recipient in Boltz can be retrieved from such a database because the database is disclosed as being able to contain information related to the date and time a person was born.

Therefore, the combination of Boltz and Littleton teach a device as claimed in claims 1, 12, and 24.

In response to the *second* argument applicant again improperly insists on arguing limitations not recited in the claims and attacking the references individually. Claims 1, 12, and 24 **do not recite** sending the electronic message based personal date information associated with the recipient. Claims 1, 12, and 24 **do recite** first recipient related information being personal date information associated with the recipient; and sending a pre-configured electronic message to the recipient based on date information and the first recipient information. As explained in the

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Final Action and the rejection above, claims 1, 12, and 24 are rejected under 35 U.S.C. 103(a) based on the combination of Boltz and Littleton. Boltz teaches sending a pre-configured electronic message to the recipient based on date information and a user defined date and time (see Boltz, col. 3, lines 24-28 and col. 4, lines 63-67). This user defined date and time reads on the claimed first recipient related information because the date and time the pre-configured message is to be delivered to the recipient is information that is directly related to the recipient (see Boltz col. 5, lines 29-32). Littleton is being combined with Boltz to teach that date and time information related to the recipient in Boltz can be personal date and time information associated with the recipient. Littleton teaches birthday information (see Littleton, paragraph [0021]). The birthday information in Littleton reads on the claimed personal date information because birthday information obviously relates to the date and time a person was born. Such information can be associated with the recipient in Boltz because the recipient in Boltz is clearly a person.

Therefore, the combination of Boltz and Littleton teach a device as claimed in claims 1, 12, and 24.

In response to the *third* argument applicant yet again improperly insists on arguing limitations not recited in the claims and attacking the references individually. Claims 1, 12, and 24 **do not recite** using personal date information as a basis for sending an electronic message. Claims 1, 12, and 24 **do recite** first recipient related information being personal date information associated with the recipient; and sending a pre-configured electronic message to the recipient based on date information and the first recipient information. As explained in the Final Action and the rejection above, claims 1, 12, and 24 are rejected under 35 U.S.C. 103(a) based on the combination of Boltz and Littleton. Boltz teaches sending a pre-configured electronic message

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to the recipient based on date information and a user defined date and time (see Boltz, col. 3, lines 24-28 and col. 4, lines 63-67). This user defined date and time reads on the claimed first recipient related information because the date and time the pre-configured message is to be delivered to the recipient is information that is directly related to the recipient (see Boltz col. 5, lines 29-32). Littleton is being combined with Boltz to teach that date and time information related to the recipient in Boltz can be personal date and time information associated with the recipient. Littleton teaches birthday information (see Littleton, paragraph [0021]). The birthday information in Littleton reads on the claimed personal date information because birthday information obviously relates to the date and time a person was born. Such information can be associated with the recipient in Boltz because the recipient in Boltz is clearly a person.

Therefore, the combination of Boltz and Littleton teach a device as claimed in claims 1, 12, and 24.

In response to applicant's *fourth* argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In addition, Littleton specifically recites an address book database containing custom fields and that one custom field may be designated for storing birthday information (see Littleton, paragraph [0021]).

Therefore, the combination of Boltz and Littleton teach a device as claimed in claims 1, 12, and 24.

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Appellant has offered no arguments regarding the patentability of dependent claims 4-5, 8-9, 11, 15-16, 19-20, and 22-23 other than that they depend from patentable independent claims 1, 12, and 24. However, because independent claims 1, 12, and 24 have been shown above to be unpatentable over Boltz and Littleton, dependent claims 4-5, 8-9, 11, 15-16, 19-20, and 22-23 are unpatentable as well as they depend from unpatentable independent claims.

Thus, the combination of Boltz and Littleton properly renders claims 1, 4-5, 8-9, 11-12, 15-16, 19-20, and 22-24 obvious.

Claims 6-7 and 17-18 are unpatentable under 35 U.S.C. 103(a) as being obvious over Boltz et al. (US 6,044,275) in view of Littleton et al. (US 2003/0023759 A1) and Kinnunen et al. (US 2001/0021649 A1).

Regarding claims 6-7 and 17-18 appellant argues that the claims are patentable based on their dependence of allegedly patentable independent claims 1, 12, and 24. However, because the independent claims 1, 12, and 24 have been shown above to be unpatentable over Boltz and Littleton the argument is rendered moot.

Claims 10 and 21 are unpatentable under 35 U.S.C. 103(a) as being obvious over Boltz et al. (US 6,044,275) in view of Littleton et al. (US 2003/0023759 A1) and Patil (US 6,625,460 B1).

Regarding claims 10 and 21 appellant argues that the claims are patentable based on their dependence of allegedly patentable independent claims 1, 12, and 24. However, because

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the independent claims 1, 12, and 24 have been shown above to be unpatentable over Boltz and Littleton the argument is rendered moot.

11. *Evidence of Appendix*

An evidence appendix is not included in the brief.

12. *Related Proceedings Appendix*

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the reasons above, it is believed that the rejections pertaining to all of the appealed claims should be sustained.

Respectfully submitted,

/Brandon J Miller/

Examiner, Art Unit 2617

Conferees:

/George Eng/

Supervisory Patent Examiner, Art Unit 2617

/Duc Nguyen/

Supervisory Patent Examiner, Art Unit 2618